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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/815,628

Filing Date: March 23, 2001

Appellant(s): VENEGAS, FRANK

MAILED

AUG 13 2004

Allen M. Krass
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 June 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because it does not correspond to the structure of Appellant's arguments in the body of the brief. Specifically, Appellant separately argues claims 17, 15 and 7. Thus, claim 15 should be considered apart from the groups set forth by Appellant.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------------------|------------------------|
| 5,396,739 | Venegas, Jr. | 03-1995 ("Venegas I") |
| 5,364,077 | Venegas, Jr. et al. | 11-1994 ("Venegas II") |
| 5,474,279 | Parisien | 12-1995 |
| 3,342,457 | Bobrowski | 02-1965 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5-8, 15, 17 and 25 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 28 January 2004. The evidentiary findings which serve as a basis for the rejections are, however, set forth below in greater detail.

Findings

Venegas I shows and discloses the following:

1. A pair of spaced apart vertical posts **12,16** each having a lower end and an upper end, the lower ends being configured to engage a support surface **48**, each of the posts **12,16** having a height and an outside diameter (see figure 1);
2. Replaceable polymerized sheathing **14,18** surrounding each of the posts **12,16**, the sheathing **14,18** having an inner diameter equal to or greater than the outside diameter of the posts **12,16**, the sheathing **14,18** extending substantially the entire height of the posts **12,16** (see figures 1-3; column 1 lines 33-43 and 55-64; column 2 lines 28-49; column 3 lines 3-23);

3. An upper rail **22** extending between the upper ends of the vertical posts **12,16** and engaged to the upper ends of the vertical posts **12,16**, the upper rail **22** having a length and an outside diameter (see figure 1; column 2 lines 28-49; column 3 lines 3-23);
4. A lower rail **26** extending between the vertical posts **12,16** and positioned below the upper rail **22**, the lower rail **26** engaged to the vertical posts **12,16** and having a length and an outside diameter (see figure 1; column 2 lines 44-46; column 3 lines 15-23);
5. Replaceable polymerized sheathing **24,28** surrounding each of the rails **22,26**, the sheathing **24,28** having an inner diameter equal to or greater than the outside diameter of the rails **22,26**, the sheathing **24,28** extending substantially the entire length of the rails **22,26** (see figures 1-3; column 1 lines 33-43 and 55-64; column 2 lines 28-49; column 3 lines 3-23);
6. The vertical posts **12,16** and the rails **22,26** together defining a perimeter frame having a framed area **30** defined therein, the framed area **30** having a top edge defined by the upper rail **22**, a lower edge defined by the lower rail **26**, and sides defined by the vertical posts **12,16** (see figure 1; column 1 lines 38-40; column 2 lines 47-49; column 3 lines 3-23);
7. An infill panel **40** supported in the framed area **30** (see figure 1; column 1 line 49; column 2 lines 63-66; column 3 lines 28-30);
8. An infill panel **40** having an area which substantially consumes the framed area **30**; the panel **40** being mounted in the framed area **30** (see figure 1; column 1 line 49; column 2 lines 63-66; column 3 lines 28-30);
9. One or more sections of U-channel **32** affixed to each of the vertical posts **12,16** and the rails **22,26** for mounting the infill panel **40** (see figures 1-3; column 2 lines 50-54 and 66-69; column 3 lines 28-30);

10. The infill panel **40** being a solid panel (see figures 1-3; column 1 line 49-54; column 2 line 63 – column 3 line 2; column 3 lines 28-30);
11. Each of the horizontal rails **22,26** and the vertical posts **12,16** comprising substantially straight members and the polymerized sheathing **14,18,24,28** is substantially straight (see figures 1-3; column 1 lines 33-43 and 55-64; column 2 lines 28-49; column 3 lines 3-23).

Venegas I *does not* teach or disclose the following:

12. The rails being releasably engaged to the posts;
13. The infill panel being a mesh screen;
14. Structural fittings interconnecting the rails with the posts, at least one of the structural fittings comprising a slip-on fitting having an inner diameter greater than or equal to the outer diameter of the plastic sheathing on the posts or rails.

Venegas II teaches and shows the following:

15. Rails **58, 50, 42** being releasably engaged to vertical posts **22** in order to facilitate easy disassembly and removal of the handrail assembly from one location and easy assembly and installation in another location (see figures 1-7 and column 1 lines 35-45).

Parisien teaches the following:

16. That mesh screens and solid infill panels are considered art recognized equivalents within the ordinary skill of the art (i.e., within the art of fence, barrier, or partition systems) (see abstract, lines 1-3).

Bobrowski teaches the following:

17. Rails **24,26** being releasably engaged to vertical posts **20,20'** in order to facilitate easy assemblage and disassembly of the guardrail assembly **10** and provide a high degree of adjustability and flexibility in size and style of the guardrail assembly **10** (see figures 1-4; column 1 lines 13-21 and column 2 lines 5-6);
18. Structural fittings **30,32,34** interconnecting the rails **24,26** with the posts **20,20'** (Bobrowski figures 1-4; columns 1-3), at least one of the structural fittings **30,32,34** comprising a slip-on fitting (see Bobrowski column 2 lines 5-6) having inner dimensions that are greater than or equal to the outer diameter of the connected posts **20,20'** or rails **24,26**.

(11) Response to Argument

All of the rejections are under 35 U.S.C. §103. The test for obviousness is what the *combined teachings* of the prior art would have suggested to one of ordinary skill in the art. See, e.g., In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (emphasis added). In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

In view of this obviousness framework and the findings above, the Examiner respectfully disagrees with Appellant's arguments for the following reasons:

- First, Appellant argues that Venegas I lacks a pair of spaced apart vertical posts having an upper end because vertical posts **12,16** do not have well-defined upper ends due to the one-piece nature of the structure (see Brief p4). The Examiner respectfully disagrees with this characterization because the vertical posts **12,16** of Venegas I can be considered to have upper ends at point **20** where the post is no longer strictly vertical (i.e., the start of the arcuate bend) as specifically set forth by Venegas I (see especially figure 1 and column 3 lines 8-14).

Even assuming, *arguendo*, that Venegas I does not meet this limitation, it is clear that the teaching references, Venegas II (figures 1-7) and Bobrowski (see figure 1), both teach releasably connected horizontal rails and vertical posts comprised of separate elements with well-defined ends. In this regard, the combination includes the limitation requiring the vertical posts to have an upper end.

- Next, Appellant argues that Venegas I lacks “*replaceable* polymerized sheathing surrounding each of the posts” (see Brief p5) (emphasis added). Clearly, Venegas I shows and discloses polymerized sheathing **14** surrounding each of the posts **12,16** as set forth in finding 2 above. Moreover, as pointed out by Appellant, the Examiner takes the position that the circumferential cut in the sheathing **14** shown in figure 3 allows the sheathing to be considered “*replaceable*”. Although Venegas I does not *explicitly* state that the sheathing is replaceable, it also does not *explicitly* teach that it is non-replaceable. Thus, the very construction of the sheathing **14** in Venegas I suggests that replacement is

at least possible. Appellant's quotation from Venegas I in lines 5-7 at page 5 of the Brief does not suggest otherwise and, in fact, seems to be irrelevant to this issue.

Furthermore, Appellant's assertion that the lower sections of posts **12 and 16** below the horizontal rail **26** are fully surrounded by the polymerized material **14** making removal impossible is unfounded and unsupported by the disclosure of Venegas I. As near as the Examiner can discern from the reference, the circumferential cut along the polymerized sheathing **14** (see figure 3) extends throughout the length of the sheathing

14. In any event, even if Appellant's assumption were true and the sheathing **14** did completely surround the bottom portions of the posts **12,16**, this would not, in the Examiner's opinion, require an interpretation that the sheathing be considered "non-replaceable".

- Third, Appellant argues that Venegas I does not show "an upper rail extending between the upper ends of the vertical posts. This argument is without merit. As set forth in finding 3 above, Venegas I clearly shows this limitation in figure 1 (see also column 3 lines 13-14).
- Fourth, Appellant argues that Venegas I lacks disclosure of replaceable polymerized sheathing surrounding each of the rails (see Brief p5). The Examiner respectfully disagrees for the same reasons indicated above with regard to the sheathing on the posts being replaceable.
- Fifth, Appellant argues that modifying Venegas I to include releasable engagement between the rail and post members according to the teachings of Venegas II would "produce a mechanical structure quite different than that disclosed in Venegas I" (see

Brief p5). In response, the Examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, the combined teachings of the references suggest releasable connections between vertical posts and horizontal rails in order to facilitate easy disassembly and removal of the handrail assembly from one location and easy assembly and installation in another location (see Venegas II figures 1-7 and column 1 lines 35-45). Moreover, it has been held that one-piece construction, in place of separate elements fastened together, and vice versa, is an obvious variation within the skill of the art. *In re Kohno*, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965).

In a supporting argument at the top of page 6 of the Brief, Appellant further argues that the rails in Venegas II “do not extend between the vertical posts” as claimed, but rather “project well beyond the [posts]”. In response to Appellant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, both Venegas I and Venegas II show rails extending between vertical posts.

Additionally, Appellant challenges the Examiner's citation to *Nerwin v. Erlichman*, for the supporting proposition that constructing integral structures as various elements involves only routine skill in the art. After a proper reading of that case, the Examiner agrees with Appellant that its teachings are inapplicable to the instant argument. Thus, the citation to that case in support of the rejection is withdrawn. This does not, however, detract from the remaining substance of the rejection.

- With regard to the rejection of claims 15 and 17 under Venegas I in view of Bobrowski, Appellant first asserts that the Examiner "does not consider the other claim limitations" (see Brief p6). On the contrary, the Examiner addressed each limitation of claim 17 in view of Venegas I (see Final Office action p5), pointed out that which Venegas I does not show (i.e., releasably engaged rails and posts), and then described how and why Bobrowski teaches such releasable engagement between rails and posts. This meets the aforementioned requirements for establishing a *prima facie* case of obviousness.

Appellant's further argument with regard to the shape of the slip-on fittings is also unpersuasive. Specifically, claim 15 essentially recites that the fitting has an inner diameter greater than or equal to the outermost diameter of member inserted therein. As stated in finding 18 above, Bobrowski teaches structural fittings **30,32,34** with inner dimensions that are equal to or greater than the outermost dimensions of the members **18,24,26** inserted therein. Thus, in response to Appellant's argument, the Examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test

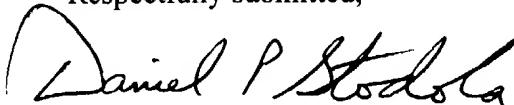
is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, Bobrowski teaches structural fittings between posts and rails in a handrail system. Venegas I discloses vertical posts **12,16** and horizontal rails **22,26** having a circular cross-section. One of ordinary skill in the art would recognize that such fittings would require a cross-sectional shape that matches the cross-sectional shape of the members inserted therein. Furthermore, citation to *In re Dailey* was merely in support of this proposition and is deemed proper as the instant Appellant similarly presents no argument that the specific configuration of their system (circular cross-section) is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious.

- Lastly, in response to Appellant's arguments against the rejection of claim 7 under Venegas I in view of Venegas II and further in view of Parisien, the Examiner simply notes that the abstract is considered to be part of the disclosure and therefore teachings set forth in the abstract are no less valid than those set forth in the drawings, specification body, etc. Moreover, in response to the argument that Parisien does not disclose or suggest use of a mesh screen for an infill panel in the "claimed environment", the Examiner is unclear as to what exactly constitutes the "claimed environment." It is assumed that this is in reference to the fact that the infill panel is included in a handrail assembly. In this regard, the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck &*

Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, the "claimed environment" is at least met by the handrail assembly described in Venegas I. Parisien is merely cited to teach that solid panels and mesh screens are considered equivalents within the art of fences, barriers, and handrails in general.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



RMF

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July 27, 2004

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